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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,660	11/26/2003	Rick James Morse	D0932-00428 [VS-8855]	8809
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DUANE MORRIS, LLP			EXAMINER	
IP DEPARTMENT			FREGA, JOHN M	
30 SOUTH 17TH STREET				
PHILADELPHIA, PA 19103-4196			ART UNIT	PAPER NUMBER
			3633	
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			06/13/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/723,660	<b>Applicant(s)</b> MORSE, RICK JAMES
	<b>Examiner</b> JOHN M. FREGA	<b>Art Unit</b> 3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 06 February 2008.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-13, 15-17, 19, 22-30 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-13, 15-17, 19 and 22-30 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 06 February 2008 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 06 February 2008

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. The following is a detailed office action on the merits for application serial number 10/723,660 in response to an amendment filed 06 February 2008. Claims 1-13, 15-17, 19, 22-30 are pending.

***Drawings***

2. The replacement drawings were received on 06 February 2008. These drawings are accepted.

***Claim Objections***

3. Claims 17, 19, and 22-24 are objected to because of the following informalities: line 6 of claim 17 recites the limitation "said vertical wall." There is insufficient antecedent basis in the claim for the limitation. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5, 17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Fifield in U.S. Patent #5,502,940.

In regards to claim 1, Fifield discloses a rectangular siding panel (item 2) having front and rear faces and a pair of side faces (see figures 5-6) said panel having a

thickened portion proximate a top end of said panel forming a protruding first area in said rear face having a continuous planar first face (see column 2, lines 6-10, which states "the surfaces of the first and second layers...may be planar or may be contoured.") extending between the side faces that is shaped to sit substantially flush with a portion of a vertical wall when said siding panel is secured to said vertical wall and angled to overlap at least a portion of a second siding panel secured to said vertical wall with said rear face including a portion proximate to a bottom end of said rear face resting upon a front face of said second siding panel, said portion of said rear face proximate to said bottom end having a planar second face extending from said bottom end to near to said first area.

In regards to claim 5, Fifield discloses the panel of claim 1 wherein said planar second face is a continuously planar face extending between the side faces (see column 2, lines 6-10).

In regards to claim 17, Fifield discloses a method of installing a siding panel assembly on a structure comprising: providing at least first and second siding panels, each of said siding panels being a rectangular shaped panel having front and rear faces and a pair of side faces, said rear face of at least said first siding panel having a first area proximate to a top end of said rear face shaped such that at least a portion of said area sits substantially flush with a portion of said vertical wall when said first siding panel is secured to said wall and angled to overlap at least a portion of said second siding panel; and attaching said first and

second siding panels to said structure such that a rear face of said first siding panel partially overlaps a front face of said second siding panel with said rear face including a portion proximate to a bottom end of said rear face resting upon a front face of said second siding panel (see figure 6), wherein said first area includes a continuous planar first face (see column 2, lines 6-10) that contacts said portion of said vertical wall and extends between said side faces and wherein said attaching step utilizes a face nail attaching method comprising driving a series of nails through said first siding panel, through said continuous planar first face and into said vertical wall.

In regards to claim 19, figure 6 shows a blind nail attachment method.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 1-3, 5-9, 11-13, 15-17, 19, 22-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art and in further view of Jakel in U.S. Patent #5,465,547. Claims 4 and 10 are rejected as being unpatentable over the admitted prior art and Jakel and further in view of Kalkanoglu et al. in U.S. PG Pub 2004/0083673.

The admitted prior art shows that it is known to provide clapboard siding panels, comprised of fiber cement, that have front, rear and two side faces, as seen in figure 1. The admitted prior art, particularly figure 3, also shows that it is

known for these panels to have continuous planar first and second faces extending between the side faces. Further, the admitted prior art teaches that both blind nail and face nail methods of installing siding panels are well known in the art.

The admitted prior art fails to disclose a thickened portion proximate a top end of said panel forming a protruding first area that is shaped to sit substantially flush with a portion of a wall.

Jakel provides rectangular fiber cement roofing panels (item 50) which may optionally be reinforced with polyester or cellulose fibers, having a thickened portion (item 54) at the top end thereof such that the top end lies flush with the underlying surface and is angled to overlap at least a portion of a second siding panel (see figure 1) with said rear face including a portion proximate to a bottom end of side rear face resting upon a front face of said second panel. Jakel shows (in figures 1 and 12) that the tiles are installed using a blind nail method. Jakel discloses panels that are reinforced with embedded polyester and/or cellulose fiber (see column 4, lines 40-49 for example), the nails will inherently pass through the reinforced area when the panels are nailed to the supporting structure.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the panels of the admitted prior art with the thickened portion of the panels of Jackel. Jackel teaches that providing such a thickened portion "is parallel to and flatly engages the roof" in order for the tile to have

"extensive three-point planar support" which would provide for a more secure connection between a panel and a wall.

Further, the particular dimensions of the tiles are viewed as a choice of design which would have been obvious to one having ordinary skill in the art at the time of the invention as no particular problem in the art is identified as being solved by the claimed dimensions and one of ordinary skill in the art would have readily recognized that the dimensions of Jakel could be varied without departing from the scope of the invention. There are no unpredictable results arrived at the by the claimed dimensions. Similarly, one of or ordinary skill in the art at the time of the invention would have readily recognized that the tiles of Jakel could have been widened without any unpredictable result, thereby arriving at a "clapboard."

The face nailing method would have been obvious in view of applicant's disclosure which recites that it was known at the time of the invention.

In regards to claims 4 and 10, the admitted prior art and Jakel do not disclose a reinforcing area comprising a mesh, scrim, fabric, or panel reinforcement. Kalkanoglu discloses a structurally similar tile that contains a scrim reinforcing layer, item 29. It would be obvious to one of ordinary skill in the art at the time of invention to provide the reinforcing scrim of Kalkanoglu in the tile of the admitted prior art and Jakel. Kalkanoglu discloses that it is known in the art to provide reinforcing, in the form of a scrim, in order to adequately resist bending torques that are applied to buildings under wind loading conditions normally faced by building structures.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-13, 15-17, 19, 22-30 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. FREGA whose telephone number is (571)270-3662. The examiner can normally be reached on Monday through Thursday, 7:30am-5:30pm E.D.T..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. F./  
Examiner, Art Unit 3633

Jmf

/Robert J Canfield/  
Supervisory Patent Examiner, Art Unit 3635